

REMARKS

This paper is submitted in response to the Office Action mailed on May 24, 2007. Claims 16-20 are pending, with claims 1-15 having been canceled without prejudice to any divisional filed thereon. No claims are amended by way of this response.

Claims 16-20 stand rejected under 35 U.S.C. 103(a) as being obvious over the combination of U.S. Patent No. 6,422,640 to Whitehead et al. ("Whitehead") and U.S. Patent No. 6,076,882 to Szerdahelyi et al. ("Szerdahelyi"). Claim 16 is the only independent claim of this group, with claims 17-20 depending directly from claim 16. For present purposes, we focus our arguments on the rejection of claim 16, for if the rejections thereof fall, the rejections of the dependent claims, particularly claims 17-20, must necessarily fall. *See, e.g., Hartness Int'l, Inc. v. Simplimatic Eng'g Co.*, 819 F.2d 1100, 1108, 2 USPQ2d 1826, 1831 (Fed. Cir. 1987) (dependent claims not obvious if independent claims not obvious over the art). Applicants do not, however, waive the right to present arguments directed specifically to the dependent claims referred above, should that become necessary.

In the Office Action, regarding claim 16, Examiner recognizes that Whitehead does not teach a top surface of the seal (24) being planar. In an effort to fill that teaching void, Examiner resorts to Szerdahelyi insofar as Szerdahelyi allegedly teaches a seal (30) having a planar surface. As such, Examiner asserts that it would have been obvious to modify the product of Whitehead to include a seal with a planar surface, as allegedly disclosed in Szerdahelyi, to provide a substantial surface area for contacting the doorframe to prevent water leakage within the vehicle. *See* Official Action at pages 2-3. Applicants respectfully disagree, and submit that the rejection of

claim 16 is in error and should therefore be withdrawn for the reasons that follow.

Examiner can appreciate that if there is a suggestion, teaching, or motivation to combine the prior art references flowing from either the references, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved, and the results are expected, then the invention is obvious and not patentable. *KRS Int'l. Co. v. Teleflex, Inc.*, 550 U.S.____, 127 S.Ct. 1727, 1739 (2007). Applicants submit that there is no such suggestion, teaching, or motivation leading one to combine the cited references. In fact, not only is the combination not desirable but Examiner's proposed modification of the seal (24) of Whitehead would change the principle of its operation and/or would render it unsatisfactory for its intended purpose, as explained below. That is impermissible.¹

Whitehead teaches a door trim assembly that includes a seal (24) that is integrally formed with an underlying carrier (20). The seal (24) purposefully includes a groove (26) so that a top surface (the surface designed to contact against an inner panel [16] of a door [12]) of the seal (24) defines a pair of laterally spaced projections (28). Whitehead is heavily reliant on this non-planar shape of the top surface of the seal (24) to compress the seal (24) and the carrier (20) against inner panel (16) (col. 3, lines 11-34). In addition, in a variation, the seal of Whitehead further includes a directly applied sealing member 142 specifically disposed in the groove 138 to compress and seal against an inner panel of a door (col. 3, line 66 to col. 4, line4). Clearly, modifying Whitehead such that the seal (24) has a planar top surface would eliminate the

¹ If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

projections (28) and the groove (26) thereof and further prevent inclusion of sealing member 142, thereby changing the principle its operation and/or rendering the seal unsatisfactory for its intended purpose. Further to that end, Examiner's proposed modification of Whitehead to incorporate the seal of Szerdahelyi appears to be based not on any proper motivation afforded by the combination of Whitehead and Szerdahelyi but rather solely on the teachings of Applicants' own specification. That is improper hindsight reconstruction, which is fatal to a §103 rejection.²

Second, even assuming *arguendo* that one skilled in the art would actually combine Whitehead and Szerdahelyi, the combination of references still fails to teach or suggest Applicants' invention as recited in claim 16.³ In particular, the seal 30 taught in Szerdahelyi does not have a planar surface, as asserted by Examiner, but rather an arcuate surface. More specifically, the specification in Szerdahelyi makes reference to only one seal, assigning reference numeral (30) thereto (col. 4, lines 29-30). The seal (30) is depicted in figures 1b, 1d, and 1f. Of these figures, only figure 1f shows the shape of the seal (30). In this figure, a portion of the seal (30) is shown exposed and extends beyond module (3). With particular reference to the exposed end of the seal (30), such end is shown to be arcuate or rounded, clearly indicating a non-planar shape of the seal (30). Similarly, and with particular reference to the unexposed portion of the seal that runs beneath the module (3), module (3) has an arcuate indentation, which

² See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) ("It is difficult but necessary that the decisionmaker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art."); MPEP §2145.

³ To establish *prima facie* obviousness of a claimed invention, it is certainly well established that all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

accommodates or molds to the shape of the seal (30). In this regard, the indentation is depicted as arcuate or rounded, which is consistent with the shape of the exposed end of seal (30) in figure 1f. This leads to only one conclusion, namely, that the seal (30) of Szerdahelyi has an arcuate shape and not a planar top surface, as required by independent claim 16. Accordingly, and contrary to Examiner's assertion, the seal (30) of Szerdahelyi does not have a planar top surface. Thus, Applicants respectfully submit that the rejection fails to present a *prima facie* case of obviousness. Therefore, the rejection of claim 16 should be withdrawn.

Moreover, as claims 17-20 depend from allowable independent claim 16, and further as each of these claims recites a combination of elements not taught or suggested in the prior art of record, Applicants respectfully submit that claims 17-20 should be allowed as well.

Conclusion

In view of the foregoing response including the amendments and remarks, this application is submitted to be in complete condition for allowance and early notice to this effect is earnestly solicited. If the Examiner believes any matter requires further discussion, the Examiner is respectfully invited to telephone the undersigned attorney so that the matter may be promptly resolved.

Applicants do not believe that any fees are due in connection with this response. However, if such petition is due or any fees are necessary, the Commissioner may consider this to be a request for such and charge any necessary fees to deposit account 23-3000.

Respectfully submitted,

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